

PATENT  
DOCKET NO.: 4526-32214**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Morea et al.	Group Art Unit:	3628
Serial No.:	09/476,384	Examiner:	Sough, Hyung Vincent, David
Filed:	December 30, 1999		
For:	A COMPUTER-IMPLEMENTABLE METHOD FOR USING AN ON-LINE CASH REGISTER (As Amended)		

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Customer No.  
**\*24728\***

Sir:

The United States Patent and Trademark Office issued a final office action dated October 6, 2005, which rejected all of the pending claims. Concurrently with a Notice of Appeal, Applicant hereby requests that a panel of examiners formally review the legal and factual basis of the examiners' rejections prior to the filing of an appeal brief and pursuant to the United States Patent and Trademark Office's "New Pre-Appeal Brief Conference Pilot Program." Applicant respectfully requests favorable reconsideration in view of the herewith presented request.

I hereby certify that this correspondence is being ☐ deposited with the United States Postal Service as First Class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, or ☒ transmitted by facsimile to 571 273 8300, on this January 6, 2006.

  
John R. Harris - Reg. No. 30,388

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Docket No.: 4526-32214**Status of the Claims**

Claims 90-176 are pending in the present application, and claims 90-176 are rejected under 35 U.S.C. 102(e) as being anticipated by *Kramer et al.* (U.S. Patent No. 6,324,525). The rejection was made final.

**Rejection under 35 U.S.C. 102(e):  
*Kramer et al.***

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In an office action dated May 2, 2005, the examiner rejected claims 90-176 under 35 U.S.C. 102(e) as being anticipated by *Kramer et al.* ("*Kramer*"). Applicant submitted a response on August 2, 2005, traversing the rejection. Please see the arguments of record in response to the May 2, 2005 rejection in the following document:

- Amendment and Response to Fourth Office Action and Record of Interview submitted by facsimile on August 2, 2005, in response to the Office Action of May 2, 2005 (pages 29-32).

The examiner also rejected the claims based on *Kramer* in an earlier office action. Please see the arguments of record with respect to the *Kramer* reference in the following document:

- Amendment and Response to Third Office Action and Record of Interview submitted by facsimile on September 23, 2003, in response to the Office Action of April 23, 2003 (pages 28-30).

As can be seen from the papers of record (including filing an RCE and interviewing the examiner), applicants have previously, and repeatedly, attempted to persuade the examiner as to the inapplicability of the *Kramer* patent, especially as regards to its teachings relating to a payment architecture. Specifically, the claimed aspects of the present invention that relate to features and operation of a payment enabling system are not disclosed, taught, or suggested by *Kramer*, or by any other reference. This is not a matter of interpretation, it is a matter that *Kramer* – legally and factually – simply has no teaching relevant to operation of a payment enabling system, as claimed.

It is clear from the present application (see in particular page 16, lines 14-22; page 38, lines 12-18, lines 24-30; FIG. 9, steps 920, 930; FIG. 10, steps 930, 920; FIG.

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11, steps 920, 930) and as recited in the claims both as originally presented and as amended, that the inventions are, in part, directed to operations of a payment enabling system that allows buyers and sellers to select and utilize payment and/or disbursement instruments, in combination with displaying branding indicia associated with the transaction facilitator, i.e. the web pages displayed to buyers and/or sellers by the payment enabling system are identically branded with the transaction facilitator. As discussed in the cited portions of the specification, this together with other aspects of the inventions allows presentation of an integrated experience to the buyers and/or sellers, in which they never realize that they are at a different site for selection of payment and/or disbursement instruments.

*Kramer* is architecturally incapable of the claimed arrangement or functionality, because it is a completely different payment architecture – one in which there is no transaction facilitator that communicates with a payment enabling system. There is no need in a *Kramer*-type architecture for displaying the branding indicia of the transaction facilitator by the payment enabler to provide the integrated buying and selling experience.

FIG. 22 of *Kramer* best illustrates that architecture: customers 2200 connect with web sites of merchants 2210, 2220, 2230, that in turn are connected to a gateway 2240 and host 2250. There is no payment enabler that handles the payment instrument (and disbursement instrument) processing for the transaction facilitator. The “payment gateway” of *Kramer* cited by the examiner (col. 18, lines 29–67) merely processes payment authorization requests, generates authorization responses, and transmits the response to the merchant computer system. (Col. 19, lines 1–14). The “payment gateway” of *Kramer* does not, *inter alia*, display information to the buyer computer for enabling the buyer to select a payment instrument, create an electronic invoice for the transaction, or display the electronic invoice to the buyer. This is not an interpretation issues – display of branding indicia is factually lacking in *Kramer*.

*Kramer* merely shows a system that provides for directing transactions to a host processor 2250 for authorization (col. 88, line 35), while the gateway 2240 mediates

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transactions between merchants and a payment processor (col. 88, lines 38–40). Neither the *Kramer* “host” nor the “gateway” meets the requirements of the transaction facilitator as the term is used in the present claims. The “internet transaction gateway” of *Kramer* as cited by the examiner does not allow two people to define a desired transaction as asserted by the examiner. (Col. 87, lines 30–65 through col. 88, lines 15–35.) The “internet transaction gateway” merely “directs transactions to a particular host processor 2250 for authorization processing ...” once process flows from a customer to a merchant and then to the internet transaction gateway. (Col. 88, lines 29–35).

Furthermore, there is no disclosure of displaying the branding indicia of the “host” (if that might be considered a “transaction facilitator”, which is not admitted). The branding indicia displayed in *Kramer*, as cited by the examiner, is merely the branding indicia of a particular payment form, e.g. VISA (FIG. 32, 33, 34). Col. 107 of *Kramer*, cited in particular by the examiner, has nothing to do with branding indicia of the transaction facilitator. The examiner asserts that the applicants fail to explicitly define “branding indicia.” This is an untenable position. With all due respect, the applicants submit that the examiner’s assertion is factually erroneous given the fact that the application explicitly states that the payment enabler employs Web pages that are branded identically to the Web pages that the transaction facilitator uses. (See application page 16, lines 14–17.) Moreover, the claims at issue require that the information displayed by the payment enabling system include the predetermined branding indicia associated with the transaction facilitator.

Stated in other words, the examiner has made a clearly improper rejection based upon an error in fact – the *Kramer* patent is directed to a conceptually and technically different payment architecture. The citations relied upon by the examiner in the rejection are technically and factually irrelevant to the claimed subject matter in this application.

The examiner’s citation of *Kramer* for a 35 U.S.C. 102(e) rejection is therefore factually erroneous given the fact that *Kramer* teaches a technically and conceptually different payment system than the payment system set forth in the claims at issue, and now on appeal. The *Kramer* reference does not anticipate, teach, or disclose a payment

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enabling system that allows buyers and sellers to select and utilize payment and/or disbursement instruments, in combination with displaying branding indicia associated with the transaction facilitator, i.e. the web pages displayed to buyers and/or sellers by the payment enabling system are identically branded with the transaction facilitator. It is therefore factually, and legally, improper for the examiner to base a rejection of the present claims on a patent that describes systems that are conceptually different from, and teach away from, the present invention.

### Conclusion

In view of the foregoing remarks, Applicant submits that the claims stand in condition for allowance, and Applicant respectfully requests the passing of the present application to issue without requiring further prosecution of an appeal.

Respectfully submitted,

MORRIS, MANNING &amp; MARTIN, LLP

January 6, 2006

Morris, Manning & Martin, L.L.P.  
1600 Atlanta Financial Center  
3343 Peachtree Road, N.E.  
Atlanta, Georgia 30326  
404 504 7720 Direct  
404 233 7000 Main

  
\_\_\_\_\_  
John R. Harris  
Reg. No. 30,388  
Attorney for applicants

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)  
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  4526-32214							
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First Named Inventor  Morea et al.									
Art Unit  3628	Examiner  Sough, Hyung & Vincent David								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>									
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,388</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p style="text-align: center;"><u><i>John R. Harris</i></u> Signature</p> <p style="text-align: center;">John R. Harris Typed or printed name</p> <p style="text-align: center;">404-233-7000 Telephone number</p> <p style="text-align: center;">10/11/2005 Date</p>							
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>									
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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